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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,687	08/05/2003	Hari Babu Sunkara	SO0017USNA	7564

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WILMINGTON, DE 19805

EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,687

Applicant(s)

SUNKARA ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,13-20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,13-20,22-28 and 30 is/are rejected.
- 7) ☒ Claim(s) 29 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Status of Claims

1. Claims 1-7, 9, 10, 13-20, and 22-31 are pending.
Claims 1-7, 9, 10, 13-20, 22-28 and 30 are rejected.
Claims 29 and 31 are objected.
Claims 8, 11, 12, and 32-34 are canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 1-7, 9, 10, 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of the term carbon black in line 3 of claim 1 is not supported in the original specification. The Applicants' attention is drawn to the attached reference (Hawley's Condensed Chemical Dictionary, twelfth edition, 1993, pages 218 and 219), wherein activated carbon and carbon black have two totally different definitions. Thus, the two terms are not necessarily the same thing and are thus not interchangeable.
4. Claims 1-7, 15-20, 22, and 23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for obtaining PO3G having a molecular weight of about 250-2250 with an APHA color less than about 50 by contacting PO3G with about 1.0 to 5.0 wt% activated carbon, does not reasonably provide enablement for obtaining PO3G having a molecular weight of about 2251-5000 with an APHA color less than about 50 by contacting PO3G with 0.1 to about 0.5 wt% activated

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carbon. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In examples 6-11 of the instant specification a color APHA of less than 50 is not obtained when 0.25 wt% of activated carbon is contacted with a PO3G having a molecular weight of 2449. In examples 13-17 of the instant specification a color APHA of less than 50 is not obtained until 1.0 wt% of activated carbon is contacted with a PO3G having a molecular weight of 2212. Thus, based upon the data obtained in Applicant's examples in order to practice the instantly claimed invention the PO3G has to have a molecular weight of less than about 2250 and use between 1.0 and 5.0 wt% activated carbon. Further, the specification does not reasonably provide enablement for using all grades of activated carbon. See Table 5, wherein only the ACTICARBONE ENO grade of 2 wt% activated carbon produced a PO3G color of less than 50. Further, claim 19 is not enabling because a 25% reduction in color did not result in a PO3G having an APHA color of less than about 50 (see Table 4 on page 13).

5. Claims 1-7, 9, 10, 13-20, 22, and 23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The initial color of the PO3G and the amount of adsorbent are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). On page 7 of Applicants response, filed April 1, 2005, they state that the molecular weight is not critical to the operability of the process and that resulting color of the PO3G is determined in part by the initial color of the PO3G and the amount of adsorbent that is utilized. However, the claims do not simultaneously contain limitations to both the initial color and amount of adsorbent.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-7, 9, 10, 13-20, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "carbon black" in claim 1 is used by the claim to mean "activated carbon", while the accepted meaning is "a finely divided form of carbon" (see page 218 of Hawley's Condensed Chemical Dictionary). The term is indefinite because the specification does not clearly redefine the term.

9. Claim 7 recites the limitation "alumina, silica, diatomaceous earth, montmorillonite clays, Fuller's earth, kaolin minerals and derivatives thereof" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim. In amended claim 1 the adsorbent has been limited to activated carbon.

10. Claims 15-18 recite the limitation "adsorbent" in line 2. There is insufficient antecedent basis for this limitation in the claim. In amended claim 1 the adsorbent has been limited to activated carbon.

11. Claim 22 recites the limitation "adsorbent" in step d. on line 7. There is insufficient antecedent basis for this limitation in the claim. In amended claim 22, the adsorbent has been limited to activated carbon in step c.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 24-28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sunkara et al. (US 2002/0010374 A1), for the reasons given in the previous office action, mailed October 20, 2004.

Allowable Subject Matter

13. Claims 29 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

14. The rejection of claims 1-8, 15-23, 29, and 32 under 35 U.S.C. 102(b) as being anticipated by Sunkara et al. (US 2002/0010374 A1) is withdrawn due to the amendment to claim 1, which limits the adsorbent to activated carbon and cancels claims 8, 21 and 32.

15. The rejection of claims 1, 8-11, 13, 14, 29, 31, 33, and 34 under 35 U.S.C. 103(a) as being unpatentable over Sunkara et al. (US 2002/0010374 A1) in view of Malloy et al. (US 4,243,831) is withdrawn due to the amendment to claim 1, which limits the adsorbent to activated carbon and cancels claims 8, 33 and 34.

Response to Arguments

Allowable Subject Matter

16. The Applicants comments with regard to the allowability of claim 1, due to the incorporation of the limitations of claim 12 have been considered. The Examiner wishes to point out to the Applicants that amended claim 1 did not include all the limitations of claim 12 and any

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intervening claim because claim 12 not only contained the temperature limitations of from about 25°C to about 100°C, but it also included the weight limitations of claim 9, i.e., about 1 to about 5 weight % of the activated carbon. This limitation was not added to claim 1 and thus amended claim 1 did not include all the limitations of claim 12 and therefore was not allowable.

Claim Rejections - 35 USC § 112, first paragraph

17. The Applicants disagree with the Examiner's rejection of claims 1-8, 15-25 and 32-34 and direct the Examiner's attention to Table 5 on page 14 of the specification. The Examiner has considered the Applicants comments, however, they are not persuasive because the claims limit the APHA color to less than about 50 and according to the Applicants own examples, this color result is not obtained when certain amounts and/or grades of activated carbon are utilized and with PO3G's have a certain molecular weight (see Tables 1-5 on pages 11-14 of Applicants specification). With respect to the arguments directed to the % reduction of color, the Examiner wishes to point out to the Applicants that according to their own examples an APHA of less than 50 was not obtained until 1% of activated carbon was utilized, which resulted in a color reduction of 40% (see Table 4 on page 13).

18. The Applicants' arguments regarding the allowability of claim 12 have been addressed above.

Claim Rejections - 35 USC § 102

19. The rejection of claims 24-28, and 30 under 35 U.S.C. 102(b) as being anticipated by Sunkara et al. (US 2002/0010374 A1) is maintained because Sunkara et al. teach a PO3G product which has a APHA color of less than about 50, which had been in contact with an inherently contains the adsorbent.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalyn Keys
Primary Examiner
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June 6, 2005